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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/162,992	09/30/1998	TADASHI SENOO	P98-1703	9466
29175	7590	12/04/2006	EXAMINER	
BELL, BOYD & LLOYD, LLC			DOVE, TRACY MAE	
P. O. BOX 1135			ART UNIT	PAPER NUMBER
CHICAGO, IL 60690-1135			1745	

DATE MAILED: 12/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/162,992

Applicant(s)

SENOO ET AL

Examiner

Tracy Dove

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-4, 6-9 and 13-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-4, 6-9 and 13-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

This Office Action is in response to the communication filed on 10/2/06. Applicant's arguments have been considered, but are not persuasive. Claims 2-4, 6-9 and 13-16 are pending. This Action is FINAL, as necessitated by amendment.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 13 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claim recites "a specific surface area that is 10 m²/g or less", which is not supported by the specification as filed. Examiner suggests "a specific surface area of 0.1-10 m²/g" in accordance with pages 9-10 of the specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-4, 6-9 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akashi, EP 0,724,305 A1, in view of Ozaki et al., US 5,522,127.

Akashi teaches a gel electrolyte and a lithium secondary cell using the gel electrolyte. The cell includes a positive electrode which may be a lithium/transition metal composite oxide, a negative electrode which may be a carbonaceous material such as graphite and the gel electrolyte. See page 5, lines 8-16. The non-aqueous solvent and the electrolyte salt used for the production of the gel electrolyte may be those generally used for the production of a lithium secondary cell. The solvent may be ethylene carbonate (EC), propylene carbonate (PC), γ -butyl lactone or mixtures thereof. The preferred salt is LiPF_6 . See page 4, lines 1-9. The gel electrolyte further includes a polymer having a side chain to which at least one nitrile group is bonded. The polymer is preferably polyacrylonitrile (PAN) and has a number-average molecular weight ranging from about 50,000 to about 500,000. See page 3, lines 45-59. A molar ratio of a monomer as a repeating unit of the PAN to the non-aqueous solvent is suitably in the range of 5:95 to 30:70 though it varies depending upon kinds of the non-aqueous solvent, the gelling agent and the electrolyte salt used. The lithium salt may be in a concentration of 0.4 to 2 M. See page 4, lines 13-17 and 31-32. Tables 1 and 2 teach a gel electrolyte including PAN, EC and PC where PC is 10-35 mol% of the gel electrolyte.

Akashi does not specifically teach the negative electrode of claim 15. Akashi teaches lithium secondary cells are well known to have a negative electrode made of a material such as lithium, a lithium alloy or a carbonaceous material capable of occluding lithium (page 2, lines 12-17). Akashi further teaches examples of suitable negative electrode activating ingredients may include metallic lithium, a lithium alloy and a carbonaceous material capable of occluding lithium, such as graphite (see page 5, lines 12-16).

However, Ozaki teaches a non-aqueous electrolyte secondary cell having a negative electrode of carbon material to which intercalation by charging and deintercalation by discharging of lithium is possible (col. 1, lines 8-12). The negative electrode is made from mesophase graphite particles. The mesophase graphite particles are produced from micro beads of mesophase carbon made from pitch (col. 3, lines 1-7). A favorable range of the specific surface area of the mesophase graphite particles is 1.0 to 8.0 m²/g, preferably 2.5 to 5.0 m²/g (5:50-58). The negative electrode was fabricated by mixing the mesophase graphite particles with styrene butadiene rubber (binder) and carboxymethyl cellulose to obtain a paste. A copper foil (current collector) of 0.02 mm thickness was coated with the paste on both surfaces and then pressed to 0.20 mm thickness. The thickness of the coated active material layer is 0.18 mm [0.20 mm (coating + current collector) - 0.02 mm (current collector)]. A thickness of 0.18 mm is equivalent to 180 μm.

Therefore, the invention as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made because one of skill would have found it obvious to use the negative electrode of Ozaki for the negative electrode of Akashi. Ozaki teaches that the negative electrode including mesophase graphite leads to smooth intercalating of lithium at charging over a wide temperature range resulting in an increased cell capacity (col. 3, lines 12-14). Akashi teaches the negative electrode may be a carbonaceous material such as graphite that is capable of occluding lithium (intercalating). Both Ozaki and Akashi teach nonaqueous secondary cells having a negative electrode including graphite and a nonaqueous electrolyte comprising a lithium salt and a mixed solvent (see col. 4, lines 54-58 of Ozaki). One of skill would be motivated to use the graphite negative electrode of Ozaki as the graphite negative

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electrode of Akashi because both materials are capable of occluding lithium and the graphite negative electrode of Ozaki leads to increased cell capacity.

Response to Arguments

Applicant's arguments filed 10/2/06 have been fully considered but they are not persuasive.

Applicant asserts Akashi does not teach or suggest a negative electrode comprising a current collector and a powder mixture including graphitized carbonized material obtained from a plurality of meso-carbon micro-beads. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Examiner admits Akashi does not teach the negative electrode of claim 15. However, Ozaki is applied in combination with Akashi to teach the negative electrode limitations of claim 15. Applicant has not addressed the Examiner's motivation for combining Akashi and Ozaki or provided convincing evidence that the two cited references are not combinable. Akashi teaches examples of suitable negative electrode activating ingredients may include metallic lithium, a lithium alloy and a carbonaceous material capable of occluding lithium, such as graphite (see page 5, lines 12-16).

Applicant asserts Ozaki fails to disclose a negative electrode having a powder mixture including a graphitized carbonaceous material obtained from a plurality of meso-carbon micro-beads and a binder, and a gel electrolyte comprising an electrolyte salt, a non-aqueous solvent and a high molecular weight material wherein the non-aqueous solvent at least includes

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propylene carbonate in an amount ranging from 10 mol% to 35 mol% and ethylene carbonate, as recited in amended claim 15. However, an anticipation rejection of claim 15 in view of Ozaki has not been applied. Ozaki is used in combination with Akashi to render claim 15 obvious. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Ozaki teaches the negative electrode of claim 15.

Applicant repeats arguments that have been determined by the Board of Patent Appeals to be non-persuasive. See Board decision of 1/19/06 affirming the Examiner and the Examiner's Answer of 3/9/04. Specifically, Akashi, not Ozaki, discloses the use of propylene carbonate as an organic solvent, and Applicant has not demonstrated why one of ordinary skill in the art would have been dissuaded from using the carbonaceous material of Ozaki for the negative electrode of Akashi. Nor has Applicant established that the use of propylene carbonate as the only solvent in Applicant's secondary cell would not experience the disadvantageous decomposition of propylene carbonate with the evolution of gas taught by Ozaki. As noted by the Examiner, the claims require as little as 10 mol% of propylene carbonate (see page 5 of the Board decision of 1/19/06).

Applicant attempts to show unexpected results for the claimed invention over the prior art of record. Applicant asserts unexpected results are shown at pages 15-24 of the specification. However, the Examples provided on pages 15-24 of the specification are not commensurate in scope with the claimed invention. For example, all of the examples on pages 15-24 recite an

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electrolyte solvent comprising 35 mol% of propylene carbonate and 65 mol% of ethylene carbonate. Claim 15 recites 10 mol% to 35 mol% of propylene carbonate in the electrolyte solvent. Claim 15 does not limit the solvent mixture to only propylene carbonate and ethylene carbonate. Furthermore, claim 15 does not require 35 mol% of propylene carbonate and 65 mol% of ethylene carbonate.

Furthermore, evidence of unexpected results must distinguish the claimed invention over the prior art of record. Akashi teaches the claimed percentage of propylene carbonate contained in the electrolyte solvent and Ozaki teaches the claimed negative electrode material. Applicant has not addressed the Examiner's motivation for combining Akashi and Ozaki.

Applicant argues Ozaki does not teach a specific surface area that ranges from 0.1-1.2 m²/g, as required by claim 16. However, Ozaki teaches a favorable range of the specific surface area of the mesophase graphite particles is 1.0 to 8.0 m²/g, preferably 2.5 to 5.0 m²/g (5:50-58). Ozaki is not limited to any preferred embodiment. The claimed endpoint of 1.2 m²/g falls within the prior art range for specific surface area. Furthermore, the disclosed endpoint 1.0 m²/g of Ozaki falls within the specific surface area range of claim 16.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tracy Dove whose telephone number is 571-272-1285. The examiner can normally be reached on Monday-Thursday (9:00-7:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pat Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

November 27, 2006



TRACY DOVE
PRIMARY EXAMINER